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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/030,571	02/24/98	CANTOR	C 25491-2401G

HM22/0619

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EXAMINER	
HOUTTEMAN, S	
ART UNIT	PAPER NUMBER
1656	18
DATE MAILED: 06/19/01	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/030,571

Applicant(s)

Cantor et al.

Examiner  
Scott Houtteman

Art Unit  
1656



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 5, 2001
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 65-122 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, and 65-122 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

- 18) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) Notice of Informal Patent Application (PTO-152)
- 20) Other \_\_\_\_\_

1. The request filed on 4/5/01 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on the parent application is acceptable and a CPA has been established. An action on the CPA follows.
2. Applicant's response, filed 4/5/01, has been carefully considered with the following effect:  
  
The rejection of paragraph 2, Office action mailed 10/4/00, has been maintained.  
  
The rejection of paragraph 2, Office action mailed 10/4/00, has been withdrawn to amended claim 3 only.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1, 2, 4, 5 and 65-110 and newly presented claims 111-122 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khrapko et al., J. DNA Sequencing and Mapping 1:375-388, 1991 (Khrapko) in view of Drmanac et al., DNA and Cell Biology 9(7):527-534, 1990 (Drmanac) for reasons of record.
5. Applicant argues, with respect to the methods of sequencing, the products used in these methods and the method of making these products; that Khrapko is drawn to the use of single stranded probes while the claims of this application are drawn to probes having a double-stranded region. This argument is not persuasive. The continuous stacking hybridization (CHS) taught by Khrapko would not be possible without a partially single stranded probe. In Khrapko, the

partially single-stranded probe is formed at the same time as the hybridization is carried out is not. The claims of the current case are generic with respect to the time before hybridization in which the partially single stranded probe single if formed. Furthermore, the ordinary artisan would reasonably expect the identical hybridization reaction to proceed independent of the time period over which the single stranded components are added.

Applicant argues that the single stranded regions of the hybrids of Khrapko are not "random" sequences. This argument is not persuasive. The specification does not specify what any length of random sequence or any particular DNA sequence. Thus any single base of the Khrapko disclosure can be considered "random."

Applicant's arguments with respect to Drmanac et al. are not persuasive because the teaching are found in Khrapko.

6. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Khrapko neither teaches nor suggests a 7-20 nucleotide C region and a 3-5 nucleotide R region.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

8. Papers relating to this application may be submitted to Technology Center 1600 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Technology Center 1600 Fax numbers are (703) 305-3014 and 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Houtteman whose telephone number is (703) 308-3885. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 8:30 AM - 3:30 PM. The examiner can also be reached on alternate Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist whose telephone number is (703) 308-0196.

Scott Houtteman  
June 18, 2001



**SCOTT W. HOUTTEMAN**  
**PRIMARY EXAMINER**